



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/802,692

03/16/2004

Gregory J. Peterson

FUT5024.04A2

3785

8156

7590

02/22/2008

JOHN P. O'BANION

O'BANION & RITCHEY LLP

400 CAPITOL MALL SUITE 1550

SACRAMENTO, CA 95814

EXAMINER

TOOMER, CEPHIA D

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

02/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/802,692	<b>Applicant(s)</b> PETERSON ET AL.	
	<b>Examiner</b> Cephia D. Toomer	<b>Art Unit</b> 1797	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 100,106 and 132-138 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 100,106,132-138 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office action is in response to the amendment filed November 19, 2007 in which claims 98, 99, 101 and 102 were canceled and claims 100, 106 and 132 were amended.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 132-133, 135 and 136 are rejected under 35 U.S.C. 102(b) as being anticipated by Hotchkiss (845).

Hotchkiss discloses an assembly for cutting cardboard, which produces an end product of burnable log-like units formed from compacted chips of the cardboard material. The cardboard is fed into a slicing means that severs the cardboard along parallel lines into a plurality of strips. The slicing means comprises an upper and lower shaft on which a plurality of circular cutting knives is found. The knives are laterally adjacent and radially overlap approximately 1/8 inch so that as the sheet material is passed through, it is subject to a slicing action to form a plurality of strips of the cardboard material. The lower shaft rotates by use of a drive motor, and the upper shaft rotates in the opposite direction by use of a gear interconnection, and rotation of the shafts causes rotation of the circular knives (Fig. 3-4, col. 2, lines 55-68; col. 3, lines 30-

68).

Regarding instant claim 132, it is the examiner's position that the radial overlapping of the blades causes an inherent slight fraying in the cut cardboard strips. A perfect alignment of the blades would create a clean cut, but it is the examiner's position that the slight overlap would cause a difference in cut and therefore the strips would exhibit slight fraying.

Accordingly, Hotchkiss teaching all the limitations of the claims anticipates the claims.

***Claim Rejections. 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 100, 134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotchkiss in view of Collier (722).

The discussion of Hotchkiss in the paragraphs above is herein incorporated by reference. Hotchkiss is silent with respect to the blades comprising a plurality of non-fluted teeth.

Collier discloses a circular blade for cutting material that comprises a plurality of aligned teeth. The teeth create a relatively narrow split or cut line, and also help prevent the edge of the blade from wearing out. It is the examiner's position that the teeth are non-fluted, because they are aligned with one another and project radially outwardly from a circumferential edge of the blade (see Fig. 3 and 4, col. 5 line 65 - col. 6, line 15).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to utilize the teeth of Collier on the blades of Hotchkiss in order to attain the advantages disclosed.

5. Claims 106, 137 and 138 are rejected under 35 U.S.C 103(a) as being unpatentable over Hotchkiss in view of Pool (360).

The discussion of Hotchkiss in the paragraphs above is herein incorporated by .. reference.

Hotchkiss is silent with respect to (i) shaft rotating means comprises spur gears, and (ii) a lower and upper guide plate that include a plurality of slots through which cutting edges of the circular knives extend therethrough, and wherein the lower and " upper guide plates form a channel therebetween for receiving and aligning cardboard sheets.

Pool discloses an assembly for cutting cardboard that produces an end product of burnable log formed from compacted chips of the cardboard. The assembly

Art Unit: 1797

comprises a slitter assembly, which severs the feed material along parallel lines into strips, and comprises a lower assembly which includes first slitter blades and an upper slitter assembly which together form a gap through which the feed material passes and is slit into strips. The slitter blades of the lower slitter assembly are disposed on a shaft located there between to hold the blades in position. Further, the assembly includes a cover with a plurality of aligned slits, through which the blades are aligned with and extend through and protrude from the slits. It is the examiner's position that the cover acts as the instant claimed "guide plate". The shaft is mounted at its ends for rotational movement, and rotates by connection through slitter shaft bearings, spacer members, and slitter gears, slitter gear key, and bull gear and associated bull gear key held in place by bull gear retainer clip. The upper slitter assembly comprises a shaft about which are disposed rubber tire spacers and which is mounted for rotational movement. A spring adjustment, adjuster, cam pin, adjuster arm, and timing gear on the upper ...- assembly serve to control the movement of the feed material. The rotational movement of the shaft causes the blades to rotate, thereby slitting the cardboard feed into strips as it passes through (col. 2, lines 50-67; col. 3, lines 1-55; Fig 1A).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to utilize the cover of Pool as a guide plate in the assembly of Hotchkiss in order to allow proper alignment of the knives.

6. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that Hotchkiss fails to teach fraying because the material is

subjected to a slicing scissor-like action. Applicant is of the opinion that such slicing would produce a clean cut.

The examiner respectfully disagrees. The blades of FIG 60 of the present invention show the relationship between the upper and lower circular blades. This figure shows that the blades are in the same configuration as FIG 4 of Hotchkiss. Given the depiction of the blades of Hotchkiss, the blades of Hotchkiss would inherently produce cardboard with frayed ends

Applicant argues that there are no advantages to using the cutting wheels of Collier because the wheels of Collier are different, as well as the material worked upon in Collier. Applicant argues that the skilled artisan would have no reason to make the combination of Hotchkiss and Collier.

The examiner respectfully disagrees. The Supreme Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result. The conclusion that when a claim simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious.

Collier is not cited for teaching the same circular blades but for teaching that circular blades with non-fluted teeth are known in the art and to utilize non-fluted teeth would yield a predictable result.

Applicant argues that claims 106 and 138 require two guide plates whereas Pool discloses an assembly having a single set of cutting blades and a single guide plate. Applicant argues that the apparatus of Hotchkiss does not need any further additions, such as guide plates.

With the use of a single guide plate, the courts have held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

With respect to Hotchkiss not needing any further additions, using a guide plate to allow proper alignment of the knives or blades would have been obvious because the use of known technique to improve similar devices would have been predictable to one of ordinary skill in the art.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cephia D. Toomer/  
Primary Examiner  
Art Unit 1797